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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,110	01/30/2004	Thomas Russell Henry	1856	9001

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EXAMINER

KRUSE, DAVID H

ART UNIT PAPER NUMBER

1638

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/769,110	<b>Applicant(s)</b> HENRY, THOMAS RUSSELL	
	<b>Examiner</b> David H Kruse	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21,22,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 1,2 and 23-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/30/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 30 April 2004 has been considered. Those application files that Applicant has requested not be published have been crossed out on the IDS form, but have been considered.

### ***Specification***

2. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper, for example on page 48, line 1 of the specification. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973). If the material is not considered by Applicant to be essential material, a statement on the record would obviate this objection (See MPEP 608.01(p)(I)).

### ***Claim Objections***

3. Claims 1, 5, 6, 13, 23 and 26 are objected to because of the following informalities:

At claim 1, "Seed" should read -- A seed -- because a claim should be directed to a single invention.

At claim 5, "Protoplasts" should read -- A protoplast -- because a claim should be directed to a single invention.

At claim 6, line 1, "are from" should read -- are produced from -- because the claim appears to unduly limit Applicant's invention to a first generation tissue culture.

At claim 13, line 2, the ":" after "of" should be deleted for consistency. See also claim 26.

At claim 23, line 1, "confers" should read -- encodes -- for consistency with claim 21.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 21, 22, 29 and 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 21, at lines 3-4, "encoding a protein...stearyl-ACP desaturase" renders the claim indefinite because Applicant only teaches a transgene encoding an antisense of stearyl-ACP desaturase at page 38, line 31. Hence, the metes and bounds of the claim are unclear. Applicant should note that "stearoyl" in the specification is misspelled, and should read -- stearyl --.

Claim 22 is indefinite because it is unclear if the claimed maize plant has the phenotype of modified fatty acid metabolism or modified carbohydrate metabolism, which the method of claim 21 is directed to. Appropriate correction is required.

Claim 29, at line 6, is indefinite for the same reason as claim 21 as directed to "stearyl-ACP desaturase". Claim 29 is also indefinite because the "nucleic acid molecule" at line 5 cannot inhibit a polypeptide; hence the metes and bounds of the claim are unclear. Claim 30 is also indefinite because it does not obviate the indefiniteness of claim 29, and for the same reason as claim 22 as directed to the maize plant produce by claim 29.

**REQUIREMENT UNDER 37 CFR §§ 1.801-1.809**

6. The Deposit Statement on page 55 of the specification is deemed in accordance with 37 CFR §§ 1.801-1.809.

Applicant is reminded that once the deposit of seed has been made, information regarding the date of deposit, description of the deposited material including number of seeds deposited, name and address of the depository, and the accession number must be added to the specification in order to comply with 37 CFR § 1.809(d). In addition, the claims must be amended to replace the blank "\_\_\_\_\_" with the appropriate Accession Number.

***Conclusion***

7. The claims are free of the prior art, which neither teaches nor fairly suggests inbred maize line PHC5H, or methods of use.

8. Claims 21, 22, 29 and 30 are rejected.

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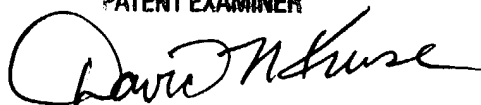
9. Claims 1, 5, 6, 13, 23 and 26 are objected to. Claims 2-4, 7-20 and 24-28 are also objected to as being dependent upon an objected base claim.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (571) 272-0804. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-0547.

DAVID H. KRUSE, PH.D.  
PATENT EXAMINER



David H. Kruse, Ph.D.  
9 December 2004

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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